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Mailed: 2/26/04
Paper No. 9
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thomas R. Tomei

Serial No. 76359997

Norman E. Lehrer for Thomas R. Tomei.

Khanh M. Le, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Seeherman, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Thomas R. Tomei has appealed from the final refusal of the Trademark Examining Attorney to register WORLDWIDE MARINE, with the word MARINE disclaimed, for "retail store services featuring boats, powerboats, sailboats, pleasure yachts, boat parts and accessories for use on boats."¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground

that applicant's mark is merely descriptive of his identified services.

Applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

It is the Examining Attorney's position that WORLDWIDE MARINE is merely descriptive because it describes the scope of applicant's retail store services and the goods he will offer for sale. In support of this refusal, the Examining Attorney has submitted the following dictionary definitions:

Worldwide: (adj.) involving or extending throughout the entire world;
universal: *a worldwide epidemic*; (adv.) throughout the world; *distributed worldwide*²

Marine: (adj.) 1.b. Of or relating to the navigation of the sea (n.) 1.b. seagoing ships esp. in relation to nationality or class.³

In addition, the Examining Attorney has submitted excerpts of articles, taken from the NEXIS database, showing that the word "marine" is used to describe boats and the sales of boats, and that "worldwide" is used to

¹ Application Serial No. 76359997, filed January 18, 2002, and asserting a bona fide intention to use the mark in commerce.

² The American Heritage Dictionary of the English Language, 3d. ed. © 1992.

³ Merriam-Webster's Collegiate Dictionary, 10th ed. © 1993.

describe businesses having stores in more than one country,

e.g.:

His company, which has offices in Fort Lauderdale, San Diego, San Francisco, Seattle, Newport, R.I., Newport Beach, Calif. (where Fraser lives) and Monaco, also has expanded into different aspects of the marine business. Besides selling boats, Fraser Yachts Worldwide offers marine insurance, helps owners charter their yachts... "Sun-Sentinel" (Fort Lauderdale, FL), October 29, 2000

Johnson Worldwide Associates Inc. is an integrated, global recreation products company engaged primarily in the marketing and distribution of fishing, camping, diving and marine products. "Business Journal-Milwaukee," June 22, 1996

Quantum International, Stroudsburg, a distributor of specialty products for worldwide automotive and marine industries... "The Morning Call" (Allentown), May 1, 1995

The marine industry is saturated by dealers that sell packaged boats. "The Arkansas Democrat-Gazette," October 11, 2002

...The strongest selling segment of the marine industry right now is luxury yachts," he added.... "Sun-Sentinel" (Fort Lauderdale, FL), February 16, 2002

Bass Pro has a soup-to-nuts marine department that sells six brands of boats.... "The Baltimore Sun," September 30, 2001

visitors can buy or sell new and used boats and other marine products.
"The Atlanta Journal and Constitution,"
February 16, 2001

Starbucks added 383 stores overseas last year and has some 6,000 stores worldwide....
"The Seattle Times," November 15, 2002

The Examining Attorney has also submitted copies of third-party registrations for, inter alia, retail distributorships in the field of sea vessels, in which the word MARINE has been disclaimed.

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). See also, In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

In this case, the evidence demonstrates that the word "marine," which applicant has disclaimed, is a merely descriptive term for the goods which applicant offers through his retail store services. The evidence also shows that "worldwide" would immediately be perceived as describing the geographic scope of applicant's retail store services. In this connection, applicant does not dispute that his services can be offered worldwide. Applicant has

made the somewhat equivocal statement, in both his response filed October 15, 2002 and his appeal brief, that "Applicant does not necessarily sell his boats worldwide." We must regard this statement as indicating that applicant may, when he does begin using the mark, offer his services in other countries. Applicant also seems to acknowledge the descriptiveness of the individual terms in his mark: "Although Appellant acknowledges that his mark may be suggestive and may even be somewhat descriptive, it is submitted that the combination is not merely descriptive." Brief, p. 2.

Applicant argues that imagination, thought and perception (the hallmarks of a suggestive mark) must be exercised because "one seeing or hearing the term WORLDWIDE MARINE would not immediately know that Appellant provides retail store services featuring boats." Brief, p. 2. However, applicant has failed to recognize that the question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods or services in the marketplace. See *In re Abcor*

Dev. Corp., supra; In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986). Thus, the question is not whether consumers can guess what services WORLDWIDE MARINE is used with, but whether consumers, upon seeing the mark WORLDWIDE MARINE used in connection with "retail store services featuring boats, powerboats, sailboats, pleasure yachts, boat parts and accessories for use on boats," would immediately understand that applicant's retail store services feature marine equipment and that they are offered in multiple countries.

As for applicant's contention that when the individual words are combined into the mark WORLDWIDE MARINE, the combination is not merely descriptive, applicant has given no explanation as to why the phrase is not merely descriptive. As we have previously discussed, in our view consumers would immediately perceive WORLDWIDE MARINE as describing applicant's identified services.

Finally, applicant has pointed to several third-party registrations for marks containing the word WORLDWIDE, in which this term was not disclaimed, and the registrations were not obtained through a showing of acquired distinctiveness. Such third-party registrations marks have little persuasive value. The Board must evaluate each application on its own merits. In re Nett Designs, 236

F.3d 1339, 57 USPQ2d 1564. Furthermore, four of the six third-party registrations are for goods, and "worldwide" is unlikely to describe features or attributes of goods. Of the other two registrations, the word MERCHANT in WORLDWIDE MERCHANT for "consulting services for establishing and using a web site on the global computer information network" does not describe the services, and WORLDWIDE describes MERCHANT. Similarly, the word WORLDWIDE in WORLDWIDE WRITERS' PLACE for providing instruction in the areas of writing and reading describes the WRITERS, not the geographic extent of the instruction services.

Decision: The refusal of registration is affirmed.